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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,624	06/26/2003	Shigeki Matsubara	KAS-185	4456

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MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.  
1800 DIAGONAL ROAD  
SUITE 370  
ALEXANDRIA, VA 22314

EXAMINER
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LEVKOVICH, NATALIA A

ART UNIT	PAPER NUMBER
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1743

MAIL DATE	DELIVERY MODE
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07/25/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/603,624

Applicant(s)

MATSUBARA ET AL.

Examiner

Natalia Levkovich

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Continued Examination***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/02/2007 has been entered.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the boxes 'in a time series', as well as the boxes displayed in two different manners, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

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and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites 'starting up operation steps being displayed in boxes in a time series'. Upon further reviewing the original specification, the Examiner found no support

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for this limitation. The specification does not support neither 'time series', nor any correlation between the arrangement of the boxes and sequence of operations.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being unclear for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

*Claim 1* recites 'starting up operation steps being displayed in boxes in a time series'. It is unclear whether the boxes are displayed in accordance with the order of the process step implementation, or whether the boxes present each step progressing in real time.

In *claim 2*, lines 2-6, the language of the Markush group is improper. See MPEP 2173.05(h). The acceptable form of a Markush group must recite members as being "selected from the group consisting of A, B and C." See *Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925).

In line 5, the 'individual test objects' lack antecedent basis.

In *claim 3*, lines 5, 'the executed time of the maintenance' lacks antecedent basis. It is also unclear whether or not the 'objects' recited in line 7, are the same as the 'individual test objects' of claim 2. Applicant is advised to use consistent terminology.

See also *claims 4, 7-8*.

With respect to *claim 5*, line 4, 'it is unclear whether or not the 'analysis item' is the same as the 'individual test object' of claim 2. Applicant is advised to use consistent terminology. Also see the 'analysis object' of *claim 8*, line 4.

In line 6, 'in a day from the present amount of the corresponding reagent', is unclear.

In *claim 6*, line 2, 'said analyses' lack antecedent basis.

In reference to *claim 9*, it is unclear how the boxes can start up an operation.

*Claim 10* recites in the pre-amble operations of sample handling and analysis. It is unclear how these operations are related to the claimed structure, since the body of the claim does not positively recite any elements which would provide for this functionality. Additionally, it is unclear as to how the 'operation steps' are inter-related with the 'procedure steps'. In lines 8-9, the 'same screen', lacks antecedent basis.

In lines 16 and 19, the 'remaining steps' lack antecedent basis.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-9 are rejected under 35 U.S.C. 102(b) as anticipated by  
Mimura et al. (US 6080364).

With respect to claims 1-2, 7 and 9, Mimura discloses an automatic analyzer comprising reaction vessels 46B, photometer 14b ['analysis part' – Ex.], computer 40 ['operating unit' – Ex.] and a display which shows an operation flow represented by a set of screens with classification captions ['boxes' – Ex.] corresponding to various operation steps, such as reagent management, accuracy management / calibration, or quality control (see Abstract and Figures 3-5). "...When a state corresponding to one of a plurality of classification captions occurs ['time series' – Ex.], the display state of the corresponding classification caption is changed"-(Col.2, lines 35-40).

Within a particular operation step, for example, calibration ['correction operation of individual test objects' – Ex.], represented by a calibration screen shown in Figure 4, blocks / boxes 401 to 404 symbolizing " a plurality of states of calibration... are displayed...When the analyzer status includes the event symbolized by the corresponding display block, the display state ['displaying manner' – Ex.] of each of the display blocks 401 to 404 ... is changed". For example, "display block 402 ... flickers [that is, the block is being displayed in a different manner which includes its color being periodically changed – Ex.] when there is an analysis item whose calibration time interval has elapsed".

In another example, when "display block 402 flickers, an operator instructs the button 406 ['at least one operation step required to be operated by an operator' – Ex.], in the display area 410, the corresponding analysis item name is displayed and the calibration of the displayed analysis item is started..." - (see Col.15, lines 5 plus).

***Claim Rejections - 35 USC § 102 / 103***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 10 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mimura et al.

Mimura et al. disclose in Figure 4 display areas 400 ['operation step display section' – Ex.] and 410 ['configuration display section' – Ex.]. When operator's input is required for any of the operation steps represented by boxes 401–404 in display area 400, a corresponding box flickers [that is, it becomes shown differently from other boxes], and "the corresponding analysis item name is displayed" in display area 410 (see Col.15, lines 5 plus). Since area 410, as illustrated in Figure 4, displays the configuration of multiple analysis items and test units, it appears that the above-mentioned 'displayed name' of the "corresponding analysis item" is shown differently from other item names. It would have been also within the ordinary skill of an artisan at the time the invention was made to have displayed items which require actions of an operator differently from



the rest of the items, in order to alert an operator and implement necessary steps on time.

### ***Response to Arguments***

12. Applicant's arguments dated 07/02/2007 have been considered but they are moot in view of new grounds of rejection.

### ***Conclusion***


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalia Levkovich whose telephone number is 571-272-2462. The examiner can normally be reached on Mon-Fri, 8 a.m.-4p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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